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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/567,788

02/16/2007

Reiner Fischer

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26111

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01/29/2009

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EXAMINER

CHU, YONG LIANG

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

01/29/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/567,788	<b>Applicant(s)</b> FISCHER ET AL.	
	<b>Examiner</b> YONG CHU	<b>Art Unit</b> 1626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 6-13 and 15-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 14 is/are rejected.
- 7) ☒ Claim(s) 1-5 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/16/2007, and 02/22/2007</u> .                              | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

Claims 1-24 are pending in the instant application.

### *Information Disclosure Statement*

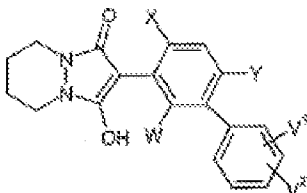
Applicants' Information Disclosure Statements, filed on 02/16/2007, and 02/22/2007, have been considered. Please refer to Applicant's copies of the PTO-1449 submitted herewith.

### *Priority*

This application is a 371 of PCT/EP2004/008638 filed on 08/02/2004, which claims the benefit of foreign priority of Germany Patent Application No. 103 37 497.3, filed on 08/14/2003.

### *Response to Restriction*

Applicants' election with traverse of Groups II (i.e. claims 1-14 and 19-21) drawn to a compound of the formula (I) according to claim 1, with elected species of the



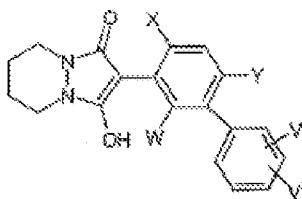
compound      Wherein W is H, X is CH<sub>3</sub>, Y is H, V' is 2-Cl, and V'' is H.      in the reply filed on 11/18/2008 is acknowledged. Applicant's argument over lack of unity of the application has been considered, but found not persuasive, because the previously cited WO2001/017973 renders the instant invention as a whole obvious. The reasons will be articulated in this Office action.

***Status of the Claims***

Claims 15-18 and 22-24 are further withdrawn from further consideration by the Examiner as being drawn to non-elected inventions under 37 CFR 1.142(b) due to the restriction requirement.

**Provisionally Elected and Examined Subject Matter**

The scope of the invention of the provisionally elected and the examined subject matter is as follows:



A compound of the formula according to the elected species, wherein:

**W** and **Y** are H, or alkyl; **X** is alkyl; **V<sup>1</sup>** is 2-Cl; **V<sup>2</sup>** is H; or a composition comprising a compound thereof.

As a result of the election and the corresponding scope of the invention identified supra, claims 6-13, 19-21, and the remaining subject matter of claims 1-5, and 14 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn compounds and compositions contain varying functional groups which are chemically recognized to differ in structure, function, and reactivity. The scope of the invention is set in considering the elected species and the preferred embodiments. In addition, a reference, which anticipates one group, would not render obvious the other.

Therefore, claims 1-5, and 14 (in part) will be examined on the merits.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

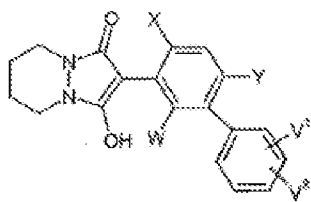
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

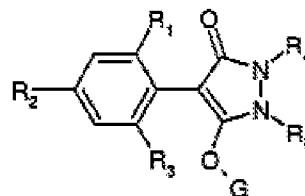
Claims 1-5, and 14 are rejected under 35 U.S.C. 103 (a) as unpatentable over PCT publication WO01/17973 ("the '973 publication") by Maetzke et al.

Applicant's instantly elected invention of claims 1-5, and 14 are related to a compound

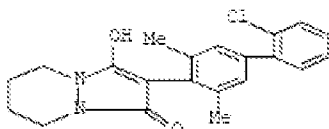


of the formula wherein: **W** and **Y** are H, or alkyl; **X** is alkyl; **V<sup>1</sup>** is 2-Cl; **V<sup>2</sup>** is H, or an herbicide composition comprising a compound thereof.

Determination of the scope and content of the prior art (MPEP §2141.01)



The '973 publication teaches an herbicide compound



with a specific compound

(CAS RN 329706-33-4) as Example

Ib-40 in Table 2, p.58.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the '973 compound and the instantly claimed compound is the position of the substituent **Z**, 2-Cl-phenyl at the para-position for the prior art, and the substituent **Z**, 2-Cl-phenyl at the meta-position relative to the pyrazole[1,2-a]pyridazin-1-one moiety.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

The instantly claimed compounds would have been obvious over the prior art teachings. It is because the prior art teaches an herbicide, which is the same utility as the instantly claimed compounds. The only difference of the substituent **Z**, 2-Cl-phenyl at the para-position would be obvious to the substituent **Z**, 2-Cl-phenyl at the meta-position, because they are structurally similar with the same chemical formula and function groups. Compounds which differ only in the placement of substituents in a ring system are not unobvious absent unexpected results. In re Jones, 162 F.2d 638, 74 USPQ 152 (CCPA 1947). The motivation to make the claimed compounds derives from the expectation that knowing properties of one member of series compounds

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would in general know what to expect in adjacent members as medicine or pesticide.

Therefore, the instant claimed compounds would have been suggested to one skilled in the art. The Office has established *prima facie* obviousness case, and the burden of coming forward with evidence or arguments shifts to the applicant who may submit additional evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art (e.g. unexpected results).

In addition, the Examiner would like also to draw Applicants' attention to the other compounds in the '973 publication, which maybe renders the non-elected subject matter unpatentable if the scope of the subject matter is expanded.

### ***Claim Objection***

Claims 1-5 are objected to because of the following informalities: each of the substituents such as **X**, and **Z** should be separated at the end by semicolon “;”, not separated by comma “,”. Appropriate corrections are required.

Claims 2-5, and 14 are objected to for depending on the rejected claim.

Claims 1-5, and 14 are provisionally objected to for containing elected and non-elected subject matter. The elected subject matter has been identified supra.

### ***Conclusion***

- Claims 1-5, and 14 are objected to.
- Claims 1-5, and 14 are rejected.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached between 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Status Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Yong Chu/  
Patent Examiner  
Art Unit 1626